

Application No.: 10/613,249

Case No.: 58817US002

REMARKS

Claims 1 to 64 are pending. Claim 46 is currently amended.

Support for the amendment to claim 46 may be found, for example, in original claim 46.

While not specifically addressed in the present office action, Applicants note that in the present Office Action the Patent Office has not maintained its § 103(a) rejection over DE 19527789 A1 as set forth in paragraph 6 of the preceding office action (Paper No. 051005). Accordingly, Applicants presume that their previous argument with regard to the § 103(a) rejection over DE 19527789 A1 has been considered by the Patent Office and found persuasive.

While not specifically addressed in the present office action, Applicants note that in the present Office Action the Patent Office has not maintained its § 103(a) rejection over Lawton (US 4,135,033) as set forth in paragraph 6 of the preceding office action (Paper No. 051005). Accordingly, Applicants presume that their previous argument with regard to the § 103(a) rejection over Applicants' alleged admissions in the specification (at page 8, line 26 through page 9, line 2) taken in view of Lawton have been considered by the Patent Office and found persuasive.

§ 103 Rejections

Claims 1-64 stand rejected under 35 USC § 103(a) as being unpatentable over Applicants' admissions in the specification at page 8, line 26 - page 9, line 2 concerning either of the references Shiba et al and WO '540, the admissions taken in view of the remaining corresponding disclosure of the appropriate one of the two references, substantially for the reasons set forth in Paragraph No. 5 of Paper No. 051005, together with the following additional observations by the Patent Office.

The Patent Office asserts that Applicants argue in their previous Response (on page 11, 1st and 2nd paragraphs) that each of the relied upon reference-admissions fail to disclose all elements (i.e., the cling backing) of applicants' three independent claims. The Patent Office argues that Shiba et al. disclose "sheets" (in col. 17, line 2) as suitable backings which can include (Col 8, lines 40-41) a PET film, which is specifically taught by applicants' specification

Application No.: 10/613,249

Case No.: 58817US002

(page 7, line 15) as a suitable thermoplastic polymeric material that can maintain an electret charge, thus qualifying as a suitable cling backing. The Patent Office further asserts that WO '540 teaches (on page 4, last three lines - page 5, first three lines) a wide variety of synthetic continuous webs which are suitable backings "such as PVC, vinyl, polyester, "Mylar", polyethylene, polypropylene, polyolefin and the like", and the Patent Office argues that almost all of these are specifically taught by Applicants' specification as suitable.

The Patent Office further asserts that Applicants make essentially no other specific traversals of the aforementioned prior art rejections, and that applicants have failed to rebut the *prima facie* case of record.

Without agreeing to the Patent Office's characterization of Applicants' supposed admissions in the specification (on page 8, line 26 - page 9, line 2), Shiba et al., or WO '540, or admitting that the rejection is even proper, Applicants submit that, notwithstanding the above remarks by the Patent Office, Applicants' supposed admissions taken in view of the disclosure of Shiba et al. and/or WO '540 fails to achieve the invention of independent claims 1, 29, and 53, and hence dependent claims 2-28, 30-52, and 54-64.

With regard to the Patent Office's characterization of the "sheets" reported by Shiba et al. as discussed hereinabove, it is submitted that just because a material can maintain an electret charge (e.g., as set forth in the specification on page 7, lines 5-17) does not imply that it necessarily has one. Rather, an electret charge must be imparted to the material (e.g., see the specification on page 6, lines 20 through page 7, line 2). Hence, merely providing a backing (e.g., a PET film) that is capable of maintaining an electret charge, but only if one is imparted to it, is *per se* insufficient to teach or properly suggest a backing (PET film) having an electret charge. It is therefore submitted that the Patent Office has failed to show that Shiba et al. teach or properly suggest a cling film as in instant claims 1, 29, and 53, much less one having a cling vinyl backing as in instant claims 4, 32, and 56, or a backing having an electret charge as in instant claims 6, 34, and 58.

With regard to the Patent Office's characterization of WO '540, it is submitted the mention of "PVC, vinyl, polyester, "Mylar", polyethylene, polypropylene, polyolefin and the

Application No.: 10/613,249

Case No.: 58817US002

like" in WO '540 on page 3, second paragraph, on pages 4-5 bridging paragraph, and claim 1) fails to teach or properly suggest a cling film. For example, as discussed above, the mere mention of a backing material that can support an electret charge, but only if one is imparted to it, is *per se* insufficient to teach or properly suggest a backing (PET film) having an electret charge. Similarly, the mere mention of PVC or vinyl is insufficient to teach or properly suggest "cling vinyl" (a plasticized and/or tackified polyvinyl chloride) film, as that term is used in the art (e.g., see U.S. Pat. No. 5,888,615 (Mascarenhas et al.) in col. 2, lines 1-35; see also, "Static Clings", Converter, Volume 37, Issue 12, December 2000, Faversham House Group, Ltd., Surrey, United Kingdom, p.14, both cited in the concurrently filed Information Disclosure Statement) and as discussed in the specification, for example, on page 5, line 21 through page 6, line 2.

It is therefore submitted that the Patent Office has failed to show that WO '540 teaches or properly suggests a cling film as in instant claims 1, 29, and 53, much less one having a cling vinyl backing as in instant claims 4, 32, and 56, or a backing having an electret charge as in instant claims 6, 34, and 58.

It is further submitted that there is no motivation for modifying the alleged admissions of Applicants in the specification at page 8, line 26 - page 9, line 2 to provide a cling film absent impermissible hindsight reasoning based on Applicants' own disclosure.

For at least these reasons, Applicants submit that the Patent Office has not made a proper *prima facie* case of obviousness in that it has failed to provide the cling backing of claims 1, 29, and 53, which are patentable. Claims 2-28, 30-52 and 54-64 add additional features to claims that are patentable, and are therefore likewise patentable.

In summary, the rejection of claims 1-64 under 35 USC § 103(a) as being unpatentable over Applicants' admissions in the specification at page 8, line 26 - page 9, line 2 concerning either of the references Shiba et al. and WO '540, the admissions taken in view of the remaining corresponding disclosure of the appropriate one of the two references, substantially for the reasons set forth in Paragraph No. 5 of Paper No. 051005 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Application No.: 10/613,249

Case No.: 58817US002

Respectfully submitted,

Dec. 28, 2005
Date

By: Bradford B. Wright
Bradford B. Wright, Reg. No.: 34,459
Telephone No.: 651-736-4172

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833